

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Dwight Allen Merriman <i>et al.</i>	Art Unit	: 3714
Serial No.	: 09/577,798	Examiner	: Ronald Laneau
Filed	: May 24, 2000	Conf. No.	: 4541
Title	: METHOD OF DELIVERY OF TARGETING, AND MEASURING ADVERTISING OVER NETWORKS		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED PETITION UNDER 37 CFR § 1.183

In response to the Petition Decision mailed January 12, 2012 and the Final Office Action mailed March 7, 2012, Applicant submits a Renewed Petition Under 37 CFR § 1.183, seeking waiver of 37 C.F.R. §§ 1.67 and 1.175 (hereinafter “Renewed Petition”).

MPEP § 409.03(a) sets forth requirements (A) through (C) that must be met when filing a petition under 37 CFR § 1.47(a). As noted in the Petition Decision, the requirements for establishing that a non-signing inventor cannot be located are the same as the requirements of 37 C.F.R. § 1.47, as set forth in Section 400 of the Manual of Patent Examining Procedure. The requirements include (A) an oath or declaration signed by all the available joint inventors on their own behalf and on behalf of the non-signing joint inventor, (B) proof that the non-signing inventor cannot be found or reached after diligent effort, and (C) the last known address of the non-signing inventor. Each of these requirements is addressed below.

(A) Oath or Declaration.

A Combined Declaration and Power of Attorney signed by the available joint inventors is filed herewith. The signature block of the non-signing inventor, Dwight Allen Merriman, is left blank.

(B) Inventor Cannot be Reached.

A Statement of Facts by Nicholas A. Bero, is filed herewith. Nicholas A. Bero, a Patent Attorney with Fish & Richardson P.C., is a person having first-hand knowledge of the facts recited therein.

(C) Last Known Addresses of non-signing Inventor Dwight Allen Merriman, according to Fish & Richardson P.C.'s contact database:

737 Washington Street
New York, NY 10014

In the Petition Decision mailed January 12, 2012, the Office dismissed the Petition filed on December 23, 2012 for allegedly failing to provide sufficient documentary evidence that a diligent effort was made to locate the non-signing inventor. In this regard, the Petition Decision states:

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence, such as Internet searches, certified mail, return receipts, cover letters of instructions, telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the non-signing inventor should be included statement of facts.

The renewed petition should detail the steps taken to locate the whereabouts of the non-signing inventor, i.e., explain how petitioner obtained the last known addresses for the inventor and provide any documentary evidence that petitioner may have that would support the fact that the address to which petitioner sent the package is the most recent address for the non-signing inventor petitioner could obtain.¹

While we do not concede the appropriateness of the dismissal, we have updated the concurrently filed Statement of Facts to further describe the efforts made to locate the non-signing inventor. Furthermore, we are providing a copy of the Certified Mailings sent to the non-signing inventor, as well as a copy of the Certified Mail Receipt.

¹ Petition Decision dated January 12, 2012.

In view of the foregoing, we respectfully request that this Renewed Petition be granted and the application be accepted as having completed all requirements for acceptance under 35 U.S.C. § 371.

Please charge to Deposit Account No. 06-1050 the petition fee in the amount of \$200.00 as set forth in 37 CFR §1.17(g). Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket 16113-1341RE9.

Respectfully submitted,

Date: March 12, 2012

/Nicholas A. Bero/

Nicholas A. Bero

Reg. No. 67,946

Customer No. 26192

Fish & Richardson P.C.

Telephone: (404)892-5005

Facsimile: (877)769-7945

FISH & RICHARDSON P.C.

One Marina Park Drive
Boston, Massachusetts
02210-1878

Telephone
617 542-5070

Facsimile
617 542-8906

Web Site
www.fr.com

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

SENT VIA CERTIFIED MAIL

February 27, 2012

Dwight Allen Merriman
737 Washington Street
New York, NY 10014

Re: Method of Delivery of Targeting, and Measuring Advertising Over Networks
(DoubleClick)

Our Ref.: 16113-1341RE9

Dear Inventor Merriman:



ATLANTA

AUSTIN

BOSTON

DALLAS

DELAWARE

HOUSTON

MUNICH

NEW YORK

SILICON VALLEY

SOUTHERN CALIFORNIA

TWIN CITIES

WASHINGTON, DC

I am a patent attorney involved in the prosecution of the above-identified case in which you are named as an inventor. During the course of prosecution, the Examiner has requested an updated Declaration from you.

A blank Declaration is attached, and we would appreciate it if you could both sign the document and return it to us by fax, email, or postal mail. Inventor O'Connor has already signed a separate copy of the Declaration, so you do not need to coordinate your efforts with him (you may simply sign on the signature line bearing your name, and leave inventor O'Connor's line blank). We are also including a copy of your application as filed, as well as the most recent amendment to the claims. The deadline for submitting this document is both urgent and imminent. Accordingly, if we do not receive the signed Declaration from you prior to March 5, 2012, we will assume that you have refused to sign the documents, and we will proceed using an alternate approach.

If you would like to discuss any aspect of the document, please feel free to give me a call at the number provided above. I look forward to hearing from you.

Very truly yours,

/Nicholas A. Bero/

Nicholas A. Bero
Associate
617.956.5962

NZB/czc
Enclosure

22797945.doc

SE

ERY

- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

Dwight Allen Merriman
737 Washington Street
New York, NY 10014

B. Received by (Printed Name)

- ☐ Agent
☐ Addressee

C. Date of Delivery

D. Is delivery address different from item 1? ☐ YesIf YES, enter delivery address below: ☐ No

3. Service Type

- ☒ Certified Mail ☐ Express Mail
☐ Registered ☒ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.

4. Restricted Delivery? (Extra Fee)

☐ Yes

2. Article Number

(Transfer from service label)

7004 1350 0002 5492 1735

PS Form 3811, February 2004

Domestic Return Receipt

102595-02-M-1540

U.S. Postal Service™ NZBero 16113-
CERTIFIED MAIL[®] RECEIPT 1341RE9
(Domestic Mail Only; No Insurance Coverage Provided)

For delivery information visit our website at www.usps.com.

OFFICIAL USE

Postage \$

Certified Fee

Return Receipt Fee
(Endorsement Required)Restricted Delivery Fee
(Endorsement Required)

Total Postage & Fees \$

Postmark
Here

Sent To

Dwight Allen Merriman

Street, Apt. No.

or PO Box No.

737 Washington Street

City, State, ZIP+4

New York, NY 10014

PS Form 3800, June 2002

See Reverse for Instructions

7004 1350 0002 5492 1735